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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 01.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT)/193/2023
(OA/SR.53/2021/PT/CHN)

QUALCOMM INCORPORATED,
(Through its constituted power of attorney
holders Mr.Tanmay Joshi and
Mr.Nipun Sangra)
a Delaware corporation having office at:
5775 Morehouse Drive,
San Diego, California 92121-1714,
United States of America ... Appellant

Vs.

The Controller of Patents
The Patent Office,
Patent Office Intellectual Property Building,
G.S.T.Road, Guindy, Chennai – 600 032. ... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) is filed under Section 117A(2) of the Indian Patents Act, 1970, seeking the following prayer;

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i. to call for the records of the patent application no.7135/CHENP/2014 relating to the impugned order;

ii. The Court may issue an order setting aside and quashing the impugned order dated December 21, 2020, for being unjust, illegal and arbitrary;

iii. Direct the Respondent to grant a patent on the patent application no.7135/CHENP/2014 allowing the present Appeal;

iv. The Appellant be allowed to amend, add or alter any ground of Appeal and also be permitted to place on record relevant material including evidence in the form of an affidavit, Written submissions and synopsis of case law;

v. Pass such other appropriate relief, order and/or direction., which this Court may deem fit and proper in the circumstances of the case and to meet the ends of justice.

For Appellant : Mr.Vineet Rohilla
Mr.Debashish Banerjee
Mr.D.Subbin
for M/s.Remfry and Sagar

For Respondent : Mr.A.R.Sakthivel,
Senior Panel Counsel

JUDGMENT

Challenging an order of the patent Controller rejecting appellant's

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application for patenting its invention titled as 'ENHANCED BLOCK-REQUEST STREAMING SYSTEM FOR HANDLING LOW-LATENCY STREAMING", this appeal is preferred.

2.The appellant's invention relates to

- *improved media streaming systems and methods, more particularly to systems and methods that are adaptive to network and buffer conditions in order to optimize a presentation of streamed media and allows for efficient concurrent, or timely-distributed, delivery of streamed media data.* For an easy understanding for a lay person the appellant's invention may be stated as one which is aimed to bring in greater efficiency in recording and transmission of video by bringing down the time lag between recording and transmission.
- The Controller came out with his FER with 4 priors (D1 to D4) and also resisted the patentiability of the petitioner's invention under Section 2(1)(ja) as lacking in inventive step, and novelty. It may be stated that the petitioner had made nine claims, of which, one is an

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independent claim. After the FER, along with its response to the same, the appellant had introduced certain amendments to his claim, which brought down the total number of claims from 9 to 7 and the independent claim count continues to be one.

- Eventually the appellant was served with a hearing notice, wherein the Controller had stuck to priorarts D1 to D4. He continued to resist patentability of the appellant's invention under the two grounds which he had raised in the FER, and added one more to it. This new objection is under Sec.59 of the Act, and it relates to the amendment. The appellant had participated in the hearing and also filed its written submissions.

3.In the final analysis, the Controller did not consider that the appellant's invention is worthy of being patented in terms of 2(1)(ja) and Section 59 of the Act.

4.Heard both sides. The learned counsel for the appellant made the following

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submissions;

- The Controller had arrived at its conclusion without reference to the written submissions as well as the response given to the FER by the appellant.
- In the first place, the Controller had merely extracted the appellant's claims as well as the amended claims and merely made a statement that the appellant had not provided support for its amended claim, and he invoked Section 59 right at this point, without caring to explain how, and how far does the amended claim exceed the original specification.
- The Controller had taken a view that the appellant herein had not responded adequately to explain how his invention is superior or different from D4, but if only he had considered the written submissions of the appellant, he would have allowed himself to be guided properly. In the written submissions it is explained as follows;

"D4 discloses segment indexing, however, does not

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provide a suggestion or disclosure that the segment index includes a presentation time range for each media fragment within the media segment, a corresponding byte range in the media segment occupied by each media fragment, and a random access point presence indicator that indicates whether a random access point is present within each media fragment. These features provide greatly improve the ability of a receiver to directly access the portions of the segment that are relevant to the current time offsets of interest, with benefits including improved content zapping times, ability to quickly change from one representation to another as network conditions vary, and reduced wastage of network resources downloading media that is not played out at a receiver of specification"

- Further, the appellant's invention has been patented at least in 15 different jurisdictions.

5.This Court carefully evaluated the submissions of the learned counsel for the appellant and also perused the records. It is evident that the Controller

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has not done a complete job of his responsibility. It is important that a Controller, when he examines an application for patent, is required to scan through the written submissions of the inventor as meticulously as possible rather than enjoying his own list of objections raised in the hearing notice. This Court finds that the objections raised by the Controller are addressed in the written submissions but, as was correctly argued by the learned counsel for the appellant, the Controller did not find it necessary to examine the written submissions before arriving at its conclusion.

6.Left with little choice, this Court allows this appeal and remands it back to the Controller of Patents for a *de novo* consideration of the appellant's application. To save embarrassment to the Controller of Patents who passed the impugned order, another Controller of Patents is directed to pass orders on the application of the appellant. The appellant is at liberty to amend its claim. The Controller of Patents who is now in charge is required to expedite the process and to pass an order within a period of six (6) months from the date of receipt of a copy of this order.

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Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes / No

N.SESHASAYEE, J.
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